REMARKS/ARGUMENTS

Claims 1-6,8-20,36,38,40,42,44,46 and 48-64 are pending in the present application. Applicants note with appreciation the Action's allowance of Claims 1-6,8, and 49. Claims 9-20,36,38,40,42,44,46,48, and 50-64 stand rejected. For the reasons set for below, Applicants submit that the rejected claims meet the statutory requirements for patentability and should be allowed.

Claims Rejection Under 35 U.S.C. § 112, First Paragraph (Enablement)

The Action rejected claims 9-20,36,38,40,42,44,46,48, and 50-64 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. The Action avers that the claims contain subject matter, which has not been described in the specification to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make/and or use the invention. In support thereof, the Action points to eight (8) factors, which are considered when determining whether the content of a disclosure contains sufficient evidence determinative of undue experimentation. (Action at 2 and 3).

In response, Applicants contend that the Action has not directly reasoned or provided sufficient evidence supporting a lack of enablement, and second, the Action has failed to fully consider applicants' previous reply - as required under MPEP § 2164.05 – which, inter alia, provided a plethora of literature directly addressing the substance of the Action's enablement rejection. Applicants maintain that the claims are fully enabled and satisfy well-recognized enablement requirements under MPEP§ 2164.08 and prevailing case law. (In re Wright, 999 F.2d 1557). Specifically, the specification supports (1) the breadth of each claim, and (2) enables one skilled in the art to make the invention without undue experimentation.

The rejected claims 9-20,36,38,40,42,44,46,48, and 50-64 are generally directed to methods for the treatment of recited disorders comprising administering to a patient in need of treatment, an effective amount of a compound according to formula I of claim 1, to inhibit the cellular sodium-proton antiporter ("NHE" or "Na+/H+-exchanger") activity of the patient.

In contrast to Action's assertion, that the claims are broadly defined to treat "any and all diseases medicated by the NHE-1 receptor," Applicants respectfully point out that the rejected claims are directed to specific diseases described in the specification. To support enablement of the rejected claims, applicants point to page 8 (lines 19-32) of the specification, which specifically discloses the claimed NHE inhibitors and their suitability for the treatment of diseases caused by ischemia/reperfusion events. Also disclosed, is the use of the claimed NHE inhibitors to treat pathophysiological processes associated with ischemia-induced cardiac arrhythmias. Furthermore, the specification, on at least, page 11, discloses the implications of NHE inhibitors in the treatment of congestive heart failure (CHF), prostate hypertrophy, and hyperplasia. In addition, the use of the compounds of formula 1 as NHE inhibitors for the treatment of hypertension in combination with calcium channel blockers is also disclosed on page 12, lines 9-15. For the treatment of elevated serum lipoproteins, a discussion of formula 1 in combination with an HMG-CoA reductase inhibitor to cause a hypolipidemic effect, can be found on page 14, lines 9-16. Moreover, while MPEP § 2164.08 requires each claim to be evaluated as a whole, applicants' specification nonetheless enables the claims for all the recited disorders and conditions. Therefore, applicants submit that the present specification enables all the limitations of the rejected claims.

With respect to the second factor, whether the specification enables one of ordinary skill in the art to make and use the invention, applicants submit that the teachings of the specification, which provide illustrative descriptions and examples, sufficiently teach a skilled artisan how to make and use the full scope of the invention. In contrast to the Action's assertions that undue experimentation would be required to reach applicant's invention, the specification provides more than a reasonable correlation to the scope of the claims. Specifically, the Examiner is invited to review pages 8 –17 of the specification which provide a detailed discussion of the correlation between the NHE inhibitors and the claimed conditions. Moreover, although, applicants teach the specific use of the NHE inhibitors and their use in treating the claimed conditions, to find enablement, it is irrelevant whether teaching is provided through broad terminology or illustrative examples. (In re Wright, 999 F.2d 1557).

In addition, to support the aforementioned teachings, Applicants in a response filed on June 29, 2005 provided a plethora of literature to support the current state of the art which

indicates a predictable relationship between the inhibition of NHE1 and the diseases recited in Applicants' claims. In this regard, Exhibit A of Applicants' Reply to the Action dated June 29, 2005 presented a summary of the literature of which Applicants are aware (along with copies of the literature), thus providing strong evidence that those of ordinary skill in the art know the link between inhibition of NHE and the conditions recited in Applicants' claims and that such conditions can be treated or prevented by inhibition of NHE.

Indeed, the MPEP makes it clear that "[a] patent need not teach, and preferably omits, what is well known in the art." MPEP § 2164.01. The Action, however, has not yet responded to this evidence by providing evidence or technical reasoning to support its position that the identification of the diseases or conditions treatable by the presently claimed compounds would constitute undue experimentation.

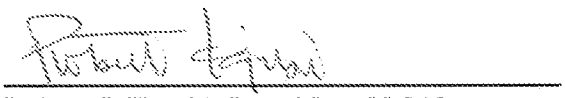
Lastly, despite the guidance provided by the 16 compounds exemplified in Applicants' specification, the Action further asserts that identification of the specific compounds encompassed by the present claims that can treat or prevent a specific disease or condition would constitute undue experimentation (Action at 8). Significantly, however, there is no legal requirement that Applicants exemplify every compound that falls within the scope of the claims. Rather, all that is required is that one skilled in the art be able to practice the claimed invention, in view of the level of knowledge and skill in the art, without undue experimentation. In this regard, the Office Action has provided no factual evidence or technical reasoning to support the bare assertions contained therein. Accordingly, in view of the above, reconsideration and withdrawal of the rejection are requested respectfully.

Conclusion

Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are requested respectfully.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. **18-1982** in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,



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